



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,710	11/28/2000	John Thomas Amend	47692-00003USPT	7699

7590

06/30/2003

Docket Clerk
P O Drawer 800889
Dallas, TX 75380

EXAMINER

BASHORE, ALAIN L

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,710

Applicant(s)

AMEND ET AL.

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) 120-124 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 6, and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

Claim 6 is rejected as indefinite for using the term "ad hoc" to describe a particular database. The term "ad hoc" means: for a particular purpose. Since the definition of a database is a collection of data stored on a computer storage medium used for more than one purpose, the term "ad hoc" is confusing and therefore indefinite.

Art Unit: 3624

Claim 78 is rejected as including an improper Markush group because of the use of "comprising in line 4.

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).

Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See Ex parte Head, 214 USPQ 551 (Bd. App. 1981); In re Gaubert, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 36-66, 71-75, 100-102 and 114-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al('878).

Art Unit: 3624

Good et al discloses a network (12) and real estate facilitator (13) connected to the network. The real estate facilitator is capable of communicating with the at least one prospective tenant and a plurality of landlords (col 4, lines 21-26, 36-41). The prospective tenant submits information specifying desired real estate (col 5, lines 63-67; col 6, lines 1-26). The facilitator includes a real estate database (col 4, lines 27-30). The facilitator allows at least one prospective tenant to select a piece of real estate in which the collection is formed responsive to the at least one desired characteristic of real estate. Good et al discloses virtual reality tours (col 3, lines 20-24) and actual visits to sites (col 3, line 37). The system and method to Good et al is real estate acquisition (finding a rental property) and outfitting (providing analysis), and the phases disclosed include: a real estate phase and an analysis phase. Good discloses a prospective tenant: reviewing a list of real estate, selecting real estate that meets at least one preliminary criterion.

Good et al does not disclose:

- a real estate demand database;
- a building database;
- notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate, or over-lapping phases;
- a real estate supply database; and,
- second party comprises at least one of a designer, an architect or an engineer.

Art Unit: 3624

Keithley et al discloses a real estate demand database (col 6, lines 43-49), a building database (col 6, lines 30-40), and notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate including over lapping phases (col 2, lines 10-23; col 6, lines 62-67)).

Keithley et al also discloses a second party comprises at least one of a designer, an architect or an engineer (col 6, lines 60-67).

It would have been obvious to one with ordinary skill in the art to include a building database and demand database to Good et al because Keithley et al teaches rental property information demand (col 1, lines 49-51) and Good et al teaches that landlords must find new ways to attract renters (col 2, lines 35-39).

It would have been obvious to one with ordinary skill in the art to include to Good et al notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate including over lapping phases because Keithley et al teaches other phases as an outgrowth of real estate demands (col 11, lines 47-66).

It would have been obvious to one with ordinary skill in the art to include transaction information and a second party to Shirley because Shirley et al teaches contract formation of different parties (col 2, lines 8-23).

Good et al and Keithley et al does not explicitly disclose:

proposal requests where the requests are sent to landlords, or proposals returned from landlords for further consideration by prospective tenants;

a real estate supply database;

changing and accessing the changed files by various parties; and,

RFIs where the requests are sent to landlords, or responses returned from landlords for further consideration by prospective tenants.

Walker et al ('878) discloses proposal requests (CPOs) that are returned for further consideration which are in a real estate supply database (500). Walker et al also discloses changing files and accessing the changed files by various parties.

It would have been obvious to one with ordinary skill in the art to discloses changing files and accessing the changed files by various parties (as claimed in claim 97) to Good et al because Walker et al ('878) teaches that offers may be modified over time which when viewed by all parties may result in acceptable conditions of a sale (col 2, lines 33-37).

It would have been obvious to one with ordinary skill in the art to include to Good et al proposal requests where the requests are sent to landlords and

Art Unit: 3624

proposals returned from landlords for further consideration by prospective tenants because of what is taught by Walker et al ('878). Walker et al ('878) teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

It would have been obvious to one with ordinary skill in the art to include to Good et al an ad hoc real estate supply database because Walker et al ('878) teaches buyer driven paradigms where the buyer has expressed an interest (col 1, lines 26-34).

It would have been obvious to one with ordinary skill in the art to include RFIs to Good et al, where the requests are sent to landlords and responses returned from landlords for further consideration by prospective tenants, because of what is taught by Walker et al ('878). Walker et al ('878) teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

5. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al ('878) as applied to claims above, and further in view of Bisdikian et al.

Art Unit: 3624

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Bisdikian et al.

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose automatically comparing new entries for matches and then linking to a second database to find matches satisfying characteristics.

Bisdikian et al discloses automatically comparing new entries for matches (col 2, line 39) and then linking to a second database to find matches satisfying characteristics (col 2, lines 40-50).

It would have been obvious to one with ordinary skill in the art to include automatically comparing new entries for matches to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Bisdikian et al teaches that search systems utilize matching techniques (col 1, line 50).

It would have been obvious to one with ordinary skill in the art to include linking to a second database to find matches satisfying characteristics to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Bisdikian et al teaches that it is common to use different databases in search systems (col 1, lines 55-67).

Art Unit: 3624

6. Claims 9-12, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al ('878) as applied to claims above, and further in view of Campbell et al.

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose selecting proposals from a RFP and sending the RFP to each landlord match.

Campbell et al discloses selecting proposals from a RFP (para 0036) and sending the RFP to each landlord match (para 0036).

It would have been obvious to one with ordinary skill in the art to include selecting proposals from a RFP to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Campbell et al teaches that criteria varies regarding providers (para 0004)

It would have been obvious to one with ordinary skill in the art to include sending the RFP to each landlord match to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Campbell et al teaches that to complete a transaction using RFPs require sending out the complete RFP to all providers (para 0036).

Art Unit: 3624

7. Claim 26-29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Walker et al ('129).

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose non-binding specifications.

Walker et al ('129) discloses non-binding specifications (col 10, lines 65-67).

It would have been obvious to one with ordinary skill in the art to include non-binding specifications to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Walker et al ('129) discloses that non-binding specifications allow leverage in negotiation (col 2, lines 65-67; col 3, lines 1-2).

8. Claim 30-35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Suci.

Good et al in view of Keithley et al and further in view of Walker et al does not disclose database described as of "expressed interest".

Suci discloses expressed interest (col 1, lines 48-50).

Art Unit: 3624

It would have been obvious to one with ordinary skill in the art to include a database of "expressed interest" to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Suciu teaches that databases specifically structured allow for efficient database transfers (col 1, lines 45-49).

9. Claim 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Olefson.

Keithly et al discloses that properties are toured (col 1, lines 59-61).

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose critiques from prospective tenants who toured properties.

Olefson discloses critiques from prospective tenants (para 0048).

It would have been obvious to one with ordinary skill in the art to include critiques from prospective tenants who toured properties to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Olefson teaches that feedback is important to real estate transactions (para 0017).

Art Unit: 3624

10. Claims 76-79, 87-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Isherwood.

Good et al in view of Keithley et al and further in view of Walker et al does not disclose acquisition and outfitting that is:

provided in parallel;

service within completion time reduced by on-line; and,

performed overlapping.

Isherwood discloses parallel and overlapping service (fig 6a), service within completion time reduced by on-line (col 4, lines 12-20).

It would have been obvious to one with ordinary skill in the art to include parallel and overlapping service to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Isherwood teaches that events may be overlapping and parallel is sequence (col 8, lines 35-45).

It would have been obvious to one with ordinary skill in the art to include service within completion time reduced by on-line use to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Isherwood on-line use as advantageous for multiple sites (col 6, lines 40-43).

Art Unit: 3624

11. Claim 80-86, 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of Sanders et al.

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose notification of information change in outfitting process, and outfitting modified by another party.

Sanders et al discloses notification of information change in outfitting process (col 29, lines 13-15), and outfitting modified by another party (col 29, lines 16-20).

It would have been obvious to one with ordinary skill in the art to include notification of information change in outfitting process to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Sanders et al teaches importance to transmit forecasts, resources required work schedules (col 29, lines 13-14).

It would have been obvious to one with ordinary skill in the art to include outfitting modified by another party to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Sanders et al teaches that changes occur in outfitting (col 29, lines 15-16).

12. Claim 103-107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in further view of Walker et al ('878) and further in view of McClelland et al.

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose request of landlord for admittance to real estate deal.

McClelland et al discloses request of a participant for admittance to real estate deal (col 23, lines 5-19).

It would have been obvious to one with ordinary skill in the art to include a request of landlord for admittance to real estate deal to Good et al in view of Keithley et al and further in view of Walker et al ('878) because McClelland et al teaches that necessary information is required for real estate deals to be verified (col 23, lines 19-21).

13. Claims 108-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al ('878) as applied to claims above, and further in view of Weatherly et al and Conklin.

Art Unit: 3624

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose monitoring a lease to detect an upcoming expiration, and triggering a lease handling routine if an upcoming expiration is detected.

Weatherly et al discloses monitoring a lease to detect an upcoming expiration, and triggering a lease handling routine if an upcoming expiration is detected (col 3, lines 3-65).

It would have been obvious to one with ordinary skill in the art to include monitoring a lease to detect an upcoming expiration, and triggering a lease handling routine if an upcoming expiration is detected because of what is taught by Weatherly et al. Weatherly et al teaches variables in a property lease need to be monitored to determine financial status (col 1, lines 12-40) and Walker et al ('878) teaches that buyers and sellers should know variables in offers made (col 3, lines 22-48).

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not further disclose automatic renewal.

Conklin et al discloses automatic renewal (col 32, lines 19-23).

Art Unit: 3624

It would have been obvious to one with ordinary skill in the art to include automatic renewal to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Conklin et al teaches that a buying scheme may require automatic renewal for banking purposes (col 32, lines 23-24).

Response to Arguments

14. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

Walker et al ('878) does disclose demand (col 1, lines 59), as broadly claimed by applicant.

Regarding allowing/providing electronic access to a plurality of entities, this is disclosed in both Good et al and Walker et al ('878).

Regarding request for information, buyer rules to Walker et al ('878) are encompassed in the broad recitation of request for information.

Regarding combining information, Good et al, Keithley et al, and Walker et al ('878) all disclose such.

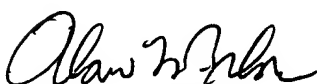
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.



Alain L. Bashore

June 24, 2003